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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/577,569	05/25/2000	Kiyonori Sekiguchi	P19529	6332
7055	7590	11/19/2004	EXAMINER	
GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			LIN, KENNY S	
			ART UNIT	PAPER NUMBER
			2154	

DATE MAILED: 11/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/577,569

Applicant(s)

SEKIGUCHI, KIYONORI

Examiner

Kenny Lin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-15, 19-22 and 24-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-15, 19-22, 24, 25 and 27 is/are rejected.
- 7) ☒ Claim(s) 26 and 28 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) *
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 12-15, 19-22 and 24-28 are presented for examination. Claims 1-11, 16-18 and 23 are canceled.

Allowable Subject Matter

2. Claims 26 and 28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

- 3.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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4. Claims 19-20 and 24 are rejected under 35 U.S.C. 102(e) as being anticipated by Akatsu et al (Akatsu), US 6,496,862.

5. Akatsu was cited in the previous office action.

6. As per claims 19 and 24, Akatsu taught the invention substantially as claimed including a gateway apparatus capable of connecting to the Internet, the apparatus being one of plurality of components in a home network (col.6, lines 33-58, col.8, lines 66-67, col.9, line 1), the apparatus comprising:

- a. An interface that is configured to connect with a receiving apparatus not having an IP address (col.7, lines 15-17);
- b. A communicator that is configured to communicate with a transmitting apparatus through the Internet (col.6, lines 52-58, col.7, lines 15-21, col.9, lines 21-25, 30-31, 33, col.10, lines 14-16);
- c. A memory that is configured to store an IP address corresponding to the receiving apparatus not having the IP address (col.6, lines 43-44, an IEEE 1394 node such as a stereo is an apparatus known not having IP address but has a physical address) and an application program which converts received data into data which the receiving apparatus not having the IP address can interpret (col.9, lines 7-19, 54-64, col.10, lines 16-25, 38-48, col.12, lines 57-58, 66-67, col.13, lines 1-10, 22-32, col.18, lines 64-67, col.18, lines 1-8, 19-23; SNMP agent), the application program being related to a property of the receiving apparatus not having the IP

address, the property indicating at least a product type of the receiving apparatus not having the IP address (col.9, lines 54-64, col.13, lines 22-32, col.18, lines 64-67, col.19, lines 1-8; MIB); and

- d. A controller that is configured to receive an Internet-frame including the IP address corresponding to the receiving apparatus not having the IP address and data from the transmitting apparatus (col.9, lines 2-6, 31-34, col.10, lines 38-39), to search the memory for the receiving apparatus not having the IP address to which the data is to be transferred, based on the corresponding IP address included in the Internet-frame (col.9, lines 54-64, col.12, lines 57-58, col.13, lines 22-32), and to transfer the data to the receiving apparatus not having the IP address (col.9, lines 59-64); wherein,
- e. Said controller converts the received data into data which the receiving apparatus not having the IP address can interpret, by utilizing the application program in the memory, when the receiving data is data which the receiving apparatus not having the IP address can not interpret (col.9, lines 7-17, 43-64, col.12, lines 57-58, 66-67, col.13, lines 1-10).

7. As per claim 20, Akatsu taught the invention as claimed in claim 19. Akatsu further taught that the data from the receiving apparatus is configured into TCP packets (col.6, lines 63-67, col.9, lines 2-17, 30-31, 33, 54-59, col.10, lines 57-67, col.11, lines 1-5).

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8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 12-14, 22, 25 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Akatsu et al (hereinafter Akatsu), US 6,496,862, in view of Lo et al (hereinafter Lo), US 6,324,178.

10. Lo was cited in the previous office action.

11. As per claims 12 and 22, Akatsu taught the invention substantially as claimed including a gateway apparatus capable of connecting to the Internet, the gateway apparatus being one of a plurality of components in a home network (col.6, lines 33-58, col.8, lines 66-67, col.9, line 1), the home network including a transmitting apparatus not having an IP address connected to the gateway apparatus (col.6, lines 43-45, col.19, lines 37-40; TV is an apparatus known not having IP address) and an input device connected to the gateway apparatus (PC, col.6, lines 40-46, col.9, lines 2-17, col.10, lines 19-23), the gateway apparatus comprising:

- a. A communicator that is configured to communicate with a receiving apparatus through the Internet (col.6, lines 52-58, col.7, lines 15-21, col.9, lines 21-25, 30-31, 33, col.10, lines 14-16);

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- b. A controller that is configured to receive data (col.9, lines 2-6, 31-34, col.10, lines 38-39), to configure the data for Internet transmission (col.9, lines 2-6, 54-64), the IP address assigned to the receiving apparatus being input by the input device (col.6, lines 34-42, col.9, lines 2-8), the transmitting apparatus not having a capability of inputting the IP address (col.6, lines 43-44, TV).

12. Akatsu did not specifically teach to generate an Internet-frame based on the data received from the transmitting apparatus and an IP address which is assigned to a receiving apparatus and to send the Internet-frame to the receiving apparatus through the communicator. Lo taught a gateway for bridging data of different communication domains to include a controller to generate an Internet-frame based on the data received from the transmitting apparatus and an IP address which is assigned to a receiving apparatus (col.1, lines 45-49, col.4, lines 52-57, col.5, lines 13-14, col.6, lines 1-19, 31-37, 43-46, col.8, lines 32-43; translating MAC address to IP address); and to send the Internet-frame to the receiving apparatus through the communicator (col.6, lines 43-46). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Akatsu and Lo because Lo's teaching of reformatting the received data with an IP address provides Akatsu's gateway to reformat data for transmission and support all communication standards (see, Lo, col.1, lines 40-49, col.2, lines 56-57, col.4, lines 52-55).

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13. As per claim 13, Akatsu and Lo taught the invention substantially as claimed in claim 12. Akatsu further taught that the input device is a personal computer (PC, col.6, lines 40-46, col.9, lines 2-17, col.10, lines 19-23).

14. As per claim 14, Akatsu and Lo taught the invention substantially as claimed in claim 12. Akatsu further taught that the controller configures the data into TCP packets for Internet transmission and generates an Internet-frame based on the TCP packet (col.6, lines 63-67, col.9, lines 2-17, 30-31, 33, 54-59, col.10, lines 57-67, col.11, lines 1-5).

15. As per claim 25, Akatsu and Lo taught the invention substantially as claimed in claim 12. Akatsu further taught that the input device is a device external of the transmitting apparatus not having the IP address (PC, col.6, lines 40-46, col.9, lines 2-17, col.10, lines 19-23).

16. As per claim 27, Akatsu and Lo taught the invention substantially as claimed in claim 22. Akatsu further taught that the IP address assigned to the receiving apparatus is input by a device external of the transmitting apparatus not having the IP address (PC, col.6, lines 40-46, col.9, lines 2-17, col.10, lines 19-23).

17. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Akatsu and Lo as applied to claim 12 above, and further in view of "Official Notice".

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18. As per claim 15, Akatsu and Lo taught the invention substantially as claimed in claim 12. Akatsu further taught that the transmitting apparatus is at least one of a printer, a television, a digital camera (col.6, lines 43-46). Akatsu and Lo did not specifically teach that the transmitting apparatus not provided with an IP address is at least one of a scanner, a refrigerator, a hot-water supply, an electric power meter and a water meter. However, Official Notice is taken that the limitations narrowed by these claims are consider obvious and furthermore a matter of design choice. It would have been obvious for the homeowner to include different apparatuses in the home network including but not limited to the listed group. It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply different apparatus that does not have direct internet access function to Akatsu and Lo's home network according to one's need or desire.

19. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Akatsu as applied to claim 19 above, and further in view of "Official Notice".

20. As per claim 21, Akatsu taught the invention substantially as claimed in claim 19. Akatsu further taught that the transmitting apparatus is at least one of a printer, a television, a digital camera (col.6, lines 43-46). Akatsu did not specifically teach that the transmitting apparatus not provided with an IP address is at least one of a scanner, a refrigerator, a hot-water supply, an electric power meter and a water meter. However, Official Notice is taken that the limitations narrowed by these claims are consider obvious and furthermore a matter of design choice. It would have been obvious for the homeowner to include different apparatuses in the

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home network including but not limited to the listed group. It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply different apparatus that does not have direct internet access function to Akatsu's home network according to one's need or desire.

Response to Arguments

21. Applicant's arguments with respect to claims 12-15, 19-22 and 24 have been considered but are moot in view of the new ground(s) of rejection.

22. Examiner has cited new area of Akatsu reference in rejecting the limitation of a receiving apparatus not having IP address (TV, stereo, DVD, digital camera), external Input device (PC), memory storing IP address and converting the received data in the rejections stated above.

23. In response to applicant's remark regarding Lo:

In the remark, applicant argued that Lo's teaching of a controller which generates "an Internet-frame based on the data received from the transmitting apparatus and an IP address which is assigned to a receiving apparatus" is incorrectly recited by the examiner since Lo taught to include a destination address in the data payload section (see page 9 of the remark). This is a direct contrast since the data received from the transmitting apparatus not having an IP address does not contain an IP address.

24. Examiner traverse the argument that:

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Lo taught in col.8, lines 32-38 that

At step 520, the present invention reads section 325 (FIG. 3A) of the data payload section 324 stored in memory 430 to obtain another destination address (*either in MAC or IP format*) for the data packet. This destination address in section 324 identifies a node of the nodes 230-236 of the second communication domain which is the ultimate receiver of the data packet. At step 525, an optional translation is performed with respect to the destination address obtained from step 520. If a MAC to IP or vice-versa translation is required, then step 525 performs the translation based on look-up tables (LUTs) stored and maintained by the bridge circuit 220 within memory unit 430.

Lo taught that the destination address could be in MAC format (not IP address) identifying a node and be translated to IP format. One of ordinary skill in the art would recognize that a MAC address or a destination address such as a physical address (physical address or node id taught by Akatsu) is not equivalent to an IP address. Although Lo taught the data packet to include a destination address, the address could be in MAC address format and not necessary an IP address. Hence, Lo's teachings reads on the claim language where says, "the data received from the transmitting apparatus not having IP address". It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Akatsu and Lo because Lo's teaching of reformatting the received data not having IP address to include an IP address provides Akatsu's gateway to reformat data for transmission and support all communication standards (see, Lo, col.1, lines 40-49, col.2, lines 56-57, col.4, lines 52-55).

Conclusion

25. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Zou, US 6,694,349.

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Saito et al, US 6,665,303.

Shingu et al, US 5,995,669.

26. A shortened statutory period for reply to this Office action is set to expire THREE MONTHS from the mailing date of this action.

27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenny Lin whose telephone number is (571) 272-3968. The examiner can normally be reached on 8 AM to 5 PM Tue.-Fri. and every other Monday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ksl
November 12, 2004

Wen-Jaw L
11/12/04